

## **REMARKS**

The Office Action of November 17 2005, has been carefully considered. Claims 1, 3-7, and 15-20 have been cancelled. The rejection of Claim 21 has been traversed. New Claims 22-28 have been added.

### **Claim Objections**

Claim 1 was objected to. Claim 1 has been cancelled.

### **Rejections Based on 35 USC § 103**

The Examiner has rejected Claims 1, 3-7, and 15 -21 under 35USC § 103 as unpatentable over Rende (US 6,523,545) in view of Ohori (US 5,490.327). Claims 1, 3-7, and 15 -20 have been cancelled.

The Applicant respectfully traverses the rejection of Claim 21. It is well known that while a new method of use for known apparatus cannot be the basis for an apparatus claim, a new method of use can be the basis for a method claim. Claim 21 is directed to a method for trimming a child's fingernails and includes a step of "illuminating an interior of a finger under the finger nail," in addition to other steps. Rende describes a dual purpose fingernail clipper and penlight (see column 5, line 7 of Rende), and describes "an electric light mounted for illuminating a region beyond said first end of said elongate members," which is the normal function of a penlight. There is no mention in Rende of using the penlight in conjunction with nail clipping, and no mention of illuminating the interior of a finger, or of any benefit obtained by illuminating the interior of a finger, or even of the possibility of illuminating the interior of a finger. Moreover, in column 2, lines 43-46, Rende states that:

"As an added feature, the housing may incorporate an electric light, with a battery, switch and series electric circuit to operate the light. The device according to the invention thus doubles as a small pen light."

Thus, Rende not only fails to describe or suggest using the light with the fingernail clipper, but Rende specifically teaches a device which has two separate and distinct uses, one as a fingernail clipper and the other as a penlight.

Ex Parte Peter J. Clark, Appeal No. 1999-2122 before The Board of Patent Appeals and Interferences, addressed the present issues. The Board found that:

"First of all, the Examiner's position completely ignores the fact that many of the appealed claims are directed to a method rather than an apparatus. As a result, the Examiner apparently believes that the prior art apparatus of the applied primary references would be capable of performing the same function as the Appellant's claimed apparatus. Even if correct, however, this belief is simply irrelevant with respect to the method claims before us. Otherwise stated, even if the prior art apparatus were capable of performing the same function as here claimed apparatus, we perceive nothing and the Examiner points to nothing in the applied references which would have suggested operating the prior art apparatus in such a manner as to perform the steps and achieve the results required by those claims under consideration which are directed to a method (e.g., see previously mentioned dependent method claim 125). Thus, with respect to such method claims, it is clear that the Examiner has failed to establish a prima facie case of obviousness."

As in Ex Parte Peter J. Clark, the applied references here do not suggest or in any way motivate all the elements of Claim 21. For example, the applied references do not suggest or in any way motivate illuminating the interior of a finger to aid in cutting a child's fingernails. The light in Rende is described as a "penlight". The position of the light in Rende is not described or shown in any detail, other than being attached to a housing for fingernail clippers. However, FIG. 4 of Rende shows the pin 24 with a stepped base which would have to protrude below the bottom of the housing 29, and the light housing 50 would necessarily reside behind the pin 24 and some additional

distance (at least the diameter of the head of the pin 24) behind the cutting edges 16 and 18. Apparatus thus configured would provide a general penlight, but could not be used to illuminate the interior of a child's finger.

Rende does not specify that the light is mounted "in a forward portion of the handle." A forward pointing light mounted farther back on the bottom of the handle would not provide light to the interior of the finger, and would not allow the present method to be practiced. Rende does not suggest using the penlight to illuminate the interior of a finger when trimming fingernails, and does not even suggest using the penlight in any coordination with trimming fingernails. Rende merely describes a penlight attached to a fingernail clipper housing to provide two independent functions in a single apparatus.

Claim 21 is not directed to merely using the invention for "illuminating a region beyond said first end," Claim 21 is specifically directed to illuminating an interior of a child's finger to aid a care giver cutting a child's fingernails. The Examiner does not point out any suggestion in Rende or Ohori for using a light attached to a fingernail clipper to illuminate the interior of a finger. Further, the Examiner does not point out any motivation provided in Rende or Ohori for the method described in Claim 21, for example, mentioning how illumination the interior of a finger might aid in cutting a child's fingernail. The Examiner merely points out structure in Rende which could be used to perform the method of Claim 21, and this assumes that the light in Rende is in the forward portion of the handle, which is not stated or shown in Rende. Because the Examiner fails to point out any suggestion or motivation for illumination of the interior of a finger to aid a care giver cutting a child's fingernail, the Applicant believes that the Examiner has failed to establish a prima facie case of obviousness, as in *Ex Parte Peter J. Clark* cited above. The Applicant therefore believes that Claim 21 is in allowable form, and respectfully requests that the rejection of Claim 21 be withdrawn and that Claim 21 be advanced to allowance.

## CONCLUSIONS

Claims 1, 3 - 11, 13, 14, and 21 remain pending in the application. New Claims 22 -31 have been added. Applicant respectfully requests that the Examiner advance Claims 1, 3 -11, 13, 14, and 21-31 to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K L Green', with a long horizontal flourish extending to the right.

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